

REMARKS

The Final Office Action mailed August 1, 2007, has been received and reviewed. Claims 1, 3-6, 8-10, 20, 22-25 and 27-29 are currently pending in the application. Claims 1, 3-6, 8-10, 20, 22-25 and 27-29 stand rejected. Applicants have added new claims 39-41. Applicants have amended claims 1, 6, 20 and 25, and respectfully request reconsideration of the application as amended herein. No new matter has been added.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,060,266 to Dent in view of U.S. Publication No. 2002/0089935 to Chan et al. and further in view of U.S. Patent No. 6,487,181 to Johnson et al.

Claims 1, 3, 6, 8, 20, 22, 25, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,060,266 to Dent (“Dent”) in view of U.S. Publication No. 2002/0089935 to Chan et al. (“Chan”) and further in view of U.S. Patent No. 6,487,181 to Johnson et al. (“Johnson”). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1, 3, 6, 8, 20, 22, 25, and 27 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations and there must be some articulated reason to combine the references.

Generally, Applicants' independent claims 1, 6, 20 and 25, recite in part, "***determining a scrambling/unscrambling sequence based on a metric ... the metric based on ... a system time interval of a channel***". The Final Office Action cites Dent for teaching "scrambling" and Chan for teaching channel metrics based on a transmission effect (e.g., error rate, signal-to-noise, time drift) and Johnson for teaching truncating a time slot when only a small amount of data is transmitted. However, none of these cited references teach determining or generating **anything** from a "system time interval," defined narrowly in the Final Office Action as a "slot". The mere fact that "words" or "phrases" are present in a collection of references does not meet the guidelines for establishing a *prima facie* case of obviousness.

Specifically, the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", as published in the Federal Register of October 10, 2007 states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* states that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, ***there must be some articulated reasoning*** with some rational underpinning to support the legal conclusion of obviousness." (57528-9; emphasis added).

Using the rejection of independent claim 1 as an example, the Final Office Action states:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of Chan into the teaching of Dent to calculate metric using system time. The modification would be obvious because one of ordinary skill in the art would be ***motivated to generate metric for indicating the channel condition, which determines the optimal packet-size***. (Final Office Action, p. 3; emphasis added).

It is respectfully submitted that Applicants' invention as claimed recites none of this. Applicants do not claim "channel condition" nor do Applicants claim anything remotely related to "packet-size." Clearly, the rejection does not meet the *KSR* holding or the patent office guidelines and should be withdrawn.

The Final Office Action continues to state:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Johnson with Dent and Chan, since one would have been *motivated to determine the truncated time slot*. The truncated time slot consume[s] less power than the transmission of a completely filled time slot, and result[s] in an increased rechargeable life of the power source []. (Final Office Action, pp. 3-4; emphasis added).

Again, it is respectfully submitted that Applicants' invention as claimed recites none of this. Applicants do not claim a "truncated time slot" nor do Applicants claim anything remotely related to truncating a time slot. Clearly, the rejection does not meet the *KSR* holding or the patent office guidelines and should be withdrawn.

Independent claims 6, 20 and 25 are similarly flawed and the Applicants' arguments are also herein sustained with respect to those rejections. Accordingly, the rejections of independent claims 1, 6, 20 and 25 are improper and should be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claim 3 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 6 precludes a rejection of claim 8 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 20 precludes a rejection of claim 22 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 25 precludes a rejection of claim 27 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Therefore, Applicants request the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 1, 3, 6, 8, 20, 22, 25 and 27.

Obviousness Rejection Based on U.S. Patent No. 5,060,266 to Dent in view of U.S. Publication No. 2002/0089935 to Chan et al. and further in view of U.S. Patent No. 6,487,181 to Johnson et al. and further in view of U.S. Patent No. 5,321,754 to Fisher et al.

Claims 4, 9, 10 and 23, 28, 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Chan in view of Johnson and in further view of U.S. Patent No. 5,321,754 to Fisher et al. (“Fisher”). Applicants respectfully traverse this rejection, as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claim 4 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 6 precludes a rejection of claims 9 and 10 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 20 precludes a rejection of claim 23 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 25 precludes a rejection of claims 28 and 29 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Therefore, Applicants request the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 4, 9, 10 and 23, 28, 29.

Obviousness Rejection Based on U.S. Patent No. 5,060,266 to Dent in view of U.S. Publication No. 2002/0089935 to Chan et al. and further in view of U.S. Patent No. 6,487,181 to Johnson et al. and further in view of U.S. Patent No. 6,973,189 to Bodin

Claims 5 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dent in view of Chan in view of Johnson and further in view of U.S. Patent No. 6,973,189 to Bodin ("Bodin"). Applicants respectfully traverse this rejection, as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claim 5 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

The nonobviousness of independent claim 20 precludes a rejection of claim 24 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Therefore, Applicants request the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 5 and 24.

CONCLUSION

Claims 1, 3-6, 8-10, 20, 22-25, 27-29, 39-41 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact the undersigned.

The Commissioner is hereby authorized to charge payment of any fee(s) or underpayment of fee(s) or credit any overpayment(s) associated with this reply to Deposit Account No. 17-0026.

Respectfully submitted,

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QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 658-5787
Facsimile: (858) 658-2502

By: /George J. Oehling/

George J. Oehling, Reg. No. 40,471
(858) 658-1761